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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,749	06/26/2002	Michael Charles Sheppard	US57.0320-WO	5993
7590	06/17/2004			
Schlumberger Doll Research Intellectual Property Law Department 36 Old Quarry Road Ridgefield, CT 06877			EXAMINER FAYYAZ, NASHMIYA SAQIB	
			ART UNIT 2856	PAPER NUMBER

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/049,749

Applicant(s)

SHEPPARD ET AL.

CA

Examiner

Nashmiya S. Fayyaz

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) 19 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Newly submitted claim 19 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 1-18 (ABbr) drawn to a system or method for making measurements with a sensor represent the combination and new claim 19 (ABsp) is directed to a robotic device for communicating represent the subcombination which is patentably distinct from the combination (claims 1-18) because all the limitations of the subcombination (claim 19) are not found in the combination and the subcombination has separate utility such as for cleaning the bore.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 19 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. Claims 1-4, 9, 12, 13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Aronstam et al - U.S. Patent # 6,443,228.

As to claims 1-4, 9, 12, 13 and 15-17, Aronstam et al disclose a method and device employing flowable devices 63 in wellbores to communicate between surface and downhole instruments, the devices include memory devices and/or sensors for measurements where the fluid moves the device in the wellbore, see Figs. 1-4, notably Fig. 4 and column 4, lines 66 et seq.

As to claim 3, note Fig. 4 and column 8, lines 31-44 which describe a “container” and “selectively” releasing the devices 209. As to claim 4, see Fig. 6 and “ceramic” capsule material 452 as in column 9, lines 57 et seq. As to claim 9, note ballast 470. As to claim 12, Aronstam et al teach that the flowable devices can be “programmed or coded” with desired information. As to claim 15, note sensors 42 within drilling assembly 30 for determining position during drilling. As to claims 16-17, note drilling assembly includes a mud motor section 32 and a power section 33 to rotate the drill bit 26 for descent.

3. Claims 5-8, 10-11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aronstam et al.

As to claims 5-8 and 10-11, Aronstam et al disclose the flowable device as in Fig. 6 but lack specifics of sealing material, or spherical shape with two hemispheres joined by plastics. Firstly, the shape is considered to have been an obvious design choice and using seals would have been obvious as well to one skill in the art at the time of the invention in order to prevent harsh fluids from entering the sensitive electronics. As to claims 10-11, the dimensions of devices are also considered to be obvious design choices to one of ordinary skill in the art at the time of invention without performing undue experimentation. As to claim 18, usage of a wireline with a drill bit is old and well-known in the wellbore art. Therefore, inclusion of a wireline is considered a matter of obvious design choice in order to retrieve the drill bit subsequent to drilling.

Response to Arguments

4. Applicant's arguments filed 12/22/03 have been fully considered but they are not persuasive. Applicant indicated a supplemental affidavit would be filed but no such affidavit has been found.

5. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashmiya S. Fayyaz whose telephone number is 571-272-2192. The examiner can normally be reached on Mondays and Thursdays.

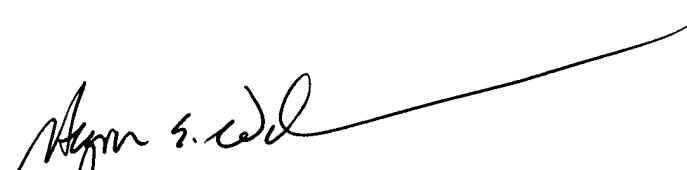
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NFayyaz
Examiner
Art Unit 2856


NF
6/14/04


HEZRON WILLIAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800